

Amendment and Response under 37 C.F.R. §1.116

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Serial No.: 10/728,446

Confirmation No.: 9352

Filed: 5 December 2003

For: SILVER COATINGS AND METHODS OF MANUFACTURE

Remarks

The Office Action dated July 24, 2008 has been received and reviewed. Claims 1 and 15 having been amended, claims 5, 36, and 40-44 having been previously cancelled, and claims 46-50 having been added, the pending claims are claims 1-4, 6-35, 37-39, and 45-50. Support for the new and amended claims can be found throughout the specification including the originally filed claims. Reconsideration and withdrawal of the rejections are respectfully requested.

Interview Summary

An Interview was conducted over the phone on September 15, 2008 between Examiner Isis Ghali and Applicants' Representative, Ann Mueeting. The statements provided by the Examiner in the interview summary mailed September 22, 2008 form a generally complete and accurate record of this interview.

Double Patenting Rejection

Claims 1-4, 6-35, 37-39, and 45 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of co-pending U.S. Patent Application No. 10/917,002. Claims 1-4, 6-35, 37-39, and 45 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-30 of co-pending U.S. Patent Application No. 10/917,102. Upon an indication of otherwise allowable subject matter and in the event these rejections are maintained, Applicants will provide an appropriate response.

The 35 U.S.C. §102 Rejection

The Examiner rejected claims 1, 2, 9-14, 25 and 45 under 35 U.S.C. §102 as being anticipated by GB 769,799. This rejection is traversed.

The Examiner is requested to note claim 1 was previously amended to recite "providing a sparingly soluble silver-containing compound selected from the group consisting of silver carbonate, silver oxide, silver stearate, silver phosphate, silver thiocyanate, and

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combinations thereof." This list does not include silver nitrate, as suggested by the Examiner at page 5 of the Office Action. Thus, this rejection must fail as all the elements of claim 1 are not in GB 769,799.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 3, 4, 7, 8, and 37 under 35 U.S.C. §103 as being unpatentable over GB 769,799 in view of WO 02/43743. The Examiner rejected claim 6 under 35 U.S.C. §103 as being unpatentable over GB 769,799 in view of U.S. Patent No. 4,592,920. The Examiner rejected claims 15-24, 26, and 38 under 35 U.S.C. §103 as being unpatentable over a combination of GB 769,799, WO 02/43743 and U.S. Patent No. 4,592,920. The Examiner rejected claims 27, 28, and 33-35 under 35 U.S.C. §103 as being unpatentable over GB 769,799 combined with U.S. Patent No. 4,592,920. The Examiner rejected claims 29-32 and 39 under 35 U.S.C. §103 as being unpatentable over GB 769,799 combined with U.S. Patent No. 4,592,920 and further in view of WO 02/43743. These rejections are respectfully traversed.

Applicants' previous arguments, particularly those submitted in the Amendment and Response dated April 23, 2008, are incorporated herein. Again Applicants point to the "teaching away" of Example 2, Treatment O in GB 769,799. In the interview the Examiner inquired as to what causes Applicants' process to result in color stability, whereas this particular example of GB 769,799 was not color stable. Applicants' Representatives submit that there is no requirement in the patent law that Applicants have to know why their process results in color stability (whether it is the composition used or in a specific step) or to claim such mechanism; they just have to teach how to carry out the process. There is no assertion that Applicants have not met this requirement.

Applicants' Representatives have studied the Examiner's comments at pages 15-20 of the Office Action, but do not fully understand. Clarification is requested. For example, it is not clear how Applicants can reproduce examples of GB 769,799 and have such comparative examples be commensurate in scope with Applicants' claims. It is respectfully submitted that the fact that they are different supports the patentability of Applicants' claims. Also, the Examiner stated at the bottom of page 16 that "the claims are not directed to stability against

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discoloration." Apparently, the Examiner overlooked the language in the last clause of independent claim 27 ("...to form a coated substrate that does not darken upon exposure to visible light"). It is respectfully submitted that darkening is a form of discoloration.

In the interest of expediting prosecution, Applicants have amended independent claims 1 and 15 to clarify that the process results in a coated substrate that is stable against darkening when exposed to at least one of visible light, ultraviolet light, electron beam, and gamma ray sterilization. There is simply no teaching or suggestion in the cited art of Applicants' claimed invention. Withdrawal of these rejections is requested.

Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

Mueting, Raasch & Gebhardt, P.A.

P.O. Box 581415

Minneapolis, MN 55458-1415

Phone: (612) 305-1220

Facsimile: (612) 305-1228

October 22, 2008

Date

By: Ann M. Mueting

Ann M. Mueting

Reg. No. 33,977

Direct Dial (612) 305-1217

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of October, 2008, at 8:38 am (Central Time).

By: Sara E. WiganName: Sara E. Wigan